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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,792	11/12/2003	Robert Gerald Kushner	50065.00008	7797

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STUART WHITTINGTON, ESQ.
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EXAMINER

MORGAN JR, JACK HOSMER

ART UNIT	PAPER NUMBER
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3782

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/712,792

Applicant(s)

KUSHNER, ROBERT GERALD

Examiner

Jack H. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11, 14 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-11, 14 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/16/2006.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 7, 17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (JP 10226279A). Suzuki et al. disclose a spectacles holder (Fig 1) with clamping means comprising an upper arm (12) and lower arm (13) further comprising a clasp means (12c, 12d, 12e) for securing the clamping means in a clamped position ([0020]), cushion means (4) to secure and support the personal item in the clamping means, attachment means (2) to attach the clamping means to a desired surface, where the attachment means comprises a clip, and tool securing means (11) for securing a provided tool (20) to said clamping means, which include a cavity or recess (between 11 and 12) dimensioned to accommodate the provided tool.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 7, 9, 10, 11, 14, 17, 18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180,133).

Ainley et al. disclose a spectacles caddy comprising a comprising a clamping body (fig 1) having a clamping position and an open position and comprising an upper arm (3) with a cushion member (19); a lower arm (2) with a cushion member (18), the lower arm being pivotally connected at one end of thereof to a corresponding end of the upper arm such that personal articles, including spectacles as well as other items (Col 1, lines 30-31) may be retained between the cushions of the upper and lower arms, said clamping body also having a cavity formed therein (un-numbered recess in the top middle face of 3, seen clearly to be a recess again in figure 4, where the 1 is pointing to). Ainley et al. also disclose an attachment means (5) connected to the clamping body. However, Ainley et al. fail to disclose a tool operative to be removably inserted into the cavity. Chang discloses a calculator (Fig 4, 60) to be removably inserted into a cavity on a similar clamping body, ie. Pivoting members that hold objects there between. Mounting the calculator allows it to be used with one hand as the calculator is supported by another structure. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the recess of Ainley et al. in such a manner to be able to removably insert a calculator, as taught by Chang in order to hold a calculator and provide a convenient mounting surface for the calculator.

In regards to claims 7, 14, 18 and 21, Ainley et al. disclose an attachment means comprising a clip (fig 1, 4 or col 2, line 49).

In regards to claims 10, 20 and 22, Ainley et al. disclose the two arms, as well as the cavity of the design being composed of injection-molded plastic (Col 3, line 63-64).

In regards to claim 17, Ainley et al. disclose the clamping means including a clasp member (21, Col 3, lines 24-30) to secure the clamping means in a closed position.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180, 133) as applied to claims 1, 2, 6, 7, 9, 10, 11, 14, and 17 above, and further in view of Leung (US 6,178,085).

Ainley et al., as modified above, disclose all the limitations of the claim except for a rotatable panel on the calculator operative in a first position to protect at least one of the keypad or display and in a second position to support the calculator in a substantially upright position. Leung discloses a calculator with a rotating cover (fig 10, 24) with a first operative position to cover the calculators display panel (fig 1) and a second operative position to form a stand for a calculator (fig 10; Col 4, lines 30-32). This allows the cover to protectively shield the keypad and display (Col 3, lines 3-4) while also propping the calculator at an angle when set on a desktop (Col 4, lines 40-41). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the eyeglass clip of Ainley et al. with the rotating cover taught by Leung in place of the basic calculator taught by Chang in order to provide

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protection for the keypad and display of the calculator and also allow it to be removed from the stand and propped up on a desktop.

4. Claims 1, 2, 7, 9, 11, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689). Holland discloses an article holder (Fig 4) with an upper arm (14), a lower arm (12) pivotally connected at one end thereof (the bottom end of the upper arm or the top end of the lower arm) to the upper arm to form a clamping body wherein personal items are secured between the arm members (between 15a and 13a), the lower arm further comprising an attachment portion (12b, see also Fig 2, 11) opposite the holding area. Holland further discloses a cavity (14a) in the upper arm and a tool (Fig 8, 330) which is disclosed as a calculator (Col 6, 15-17) operative to be removably inserted into said cavity. Holland does not disclose a cushion disposed on the bottom side of the upper arm, opposite the tool holding cavity, a cushion on the top side of the lower arm, opposite the attachment portion or the attachment portion comprising a clip. Jo discloses a personal article holder (Fig 3) comprising an upper arm (10), a lower arm (11) and an attachment clip (12) to hold the clip to a belt (26) or other clothing (Col 2, lines 53-55). Furthermore, Jo discloses two cushions, a first cushion (16) on the bottom of the upper arm, and a second cushion (18) on the top of the lower arm where these cushions work together to ensure a secure grip on the object held, as well as help avoid disfiguring the item in question (Col 2, lines 66-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to make the article

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holder of Holland with the cushions and attachment clip of Jo in order to securely grip the item being held without damaging it, as well as to attach the object holder onto the clothing of a user.

5. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689) as applied to claims 1, 2, 7, 9, 11, 14 and 18 above, and further in view of Ainley et al. (US 6,728,995). Holland as modified above discloses all the limitations of the claims except for the upper and lower arm members formed from an injection molded plastic material, though Holland does disclose the upper and lower arm members being made from polymeric materials, which are plastics (Col 3, lines 31-34). Ainley et al. disclose a hinged object carrier (Fig 1) whose arms (2, 3) are fabricated as injection moldings from a rigid plastic (Col 3, lines 63-65). As injection molding is a well known method for inexpensively manufacturing plastic objects, it would have been obvious to one of ordinary skill in the art at the time of invention to create the article holder of Holland as modified above with injection molded plastic arms in order to save money during production.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689) as applied to claims 1, 2, 7, 9, 11, 14 and 18 above, and further in view of Leung (US 6,178,085). Holland as modified above discloses all the limitations of the claim except for a rotatable panel on the calculator operative in a first position to protect at least one of the keypad or display and in a

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second position to support the calculator in a substantially upright position. Leung discloses a calculator with a rotating cover (fig 10, 24) with a first operative position to cover the calculators display panel (fig 1) and a second operative position to form a stand for a calculator (fig 10; Col 4, lines 30-32). This allows the cover to protectively shield the keypad and display (Col 3, lines 3-4) while also propping the calculator at an angle when set on a desktop (Col 4, lines 40-41). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the article holder of Holland's removable calculator (Fig 8, 330) as modified above with the rotating cover taught by Leung in order to provide protection for the keypad and display of the calculator and also allow it to be removed from the article holder and be propped up on a desktop.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689) and Ainley et al. (US 6,728,995) as applied to claims 10 and 20 above, and further in view of Suzuki et al. (JP 10226279). Holland as modified above discloses all the limitations of the claim except for the upper and lower arms being formed specifically of Acrylnitrile-Butadiene-Styrene (ABS) plastic although they do disclose the upper and lower arms as being formed of injection molded plastic (See above). Suzuki et al. disclose a case formed of ABS resin. ABS is well known for being a plastic with high impact resistance and toughness. It would have been obvious to one of ordinary skill in the art to create the arm members of Holland as

modified above with the ABS plastic of Suzuki et al. in order to gain the benefit of ABS plastic's increased impact resistance and toughness.

8. Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (JP 10226279) in view of Ainley et al. (US 6,728,995). Suzuki et al. disclose all the limitations of the claims except for the clamping means comprising an upper and a lower arm formed of injection molded plastic. Ainley et al. disclose a spectacles caddy which is comprised of injection molded plastic (Col 3, lines 63-64). As Suzuki et al. disclose a case formed of plastic, specifically ABS resin ([0014]), and injection molding is a well known method for inexpensively mass-producing plastic items, It would have been obvious to one of ordinary skill in the art at the time of invention to make the spectacles caddy of Suzuki et al. with the injection molded plastic of Ainley et al. in order to inexpensively produce the spectacles caddy.

Response to Arguments

Applicant's arguments filed 11/16/2006 have been fully considered but they are not persuasive. In regards to the 35 USC 103 rejection of claims 1-2 and 6-17, Ainley et al. in view of Chang, applicant contends that there is no motivation to combine the two references (page 11 of response). Applicant states "the motivation suggested in the Office Action is entirely lacking any reason whatsoever as to why the skilled artisan would bother to modify the Spectacles Caddy 10 disclosed by Ainley with the clipboard

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including calculator disclosed by Chang." Further, applicant states "Ainley indisputably discloses a caddy designed solely for holding various types of spectacles."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ainley et al. disclose a clamping body which holds objects, including, but not limited to spectacles (see Ainley et al. Col 1, lines 30-31), the clamping body having a recess on the top face of one arm, the arm not connected to the attachment mechanism (a clip) of the clamping body. Chang discloses a similar clamping body with a recess, said recess being adapted to hold a calculator in order to use the calculator with one hand, as the calculator is supported by the clamping body it is set into, this recess is also on arm of the clamping body not connected to the attachment mechanism (a pin hole) of the clamping body. It would have been obvious to modify the recess in Ainley et al. to replicate the recess in Chang in order to support the calculator by the clamping body of Ainley et al.

In response to applicant's argument that Ainley discloses a caddy designed solely for spectacles, examiner cites Ainley et al. column 1, lines 30 and 31 which refers to spectacles or other items held by the clamping body.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Clearly in the instant case, Ainley et al. and Chang both teach clamping devices to hold various articles and therefore one of ordinary skill in the art would look to the combined teachings of Ainley et al. and Chang. As a result to modify the recess of Ainley et al. to fit a calculator in said recess as taught by Chang would have been obvious to one of ordinary skill in the art at the time of invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack H. Morgan whose telephone number is 571-272-3385. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jack H Morgan
Examiner
Art Unit 3782


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER